

REMARKS

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 1-15 and 25-26 pending. The application has been carefully reviewed in light of the Office Action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

Claim Objections

The Examiner has objected to claims 1-9 because in claim 1, line 2, the phrase “is-coated” should apparently be “is coated.” The reason that the phrase appears to be written as “is-coated” is because the word processing program has marked the text that was amended in the previous Amendment C. Upon closer examination of the Examiner’s comment, it appears that the word processing program marked the text as “is-_coated,” meaning it recognized a deletion of the space between the words “is coated” and an insertion of a space between the words in order to separate them. Therefore, because the noted markings are a result of markings to show changes made, and are not part of the claim as written, is believed that no correction is necessary to address the Examiner’s objection.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 1-3 and 10-13 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. (U.S. Patent No. 6,112,665) and Lerner et al. (U.S. Patent No. 6,416,612). Applicants traverse this rejection for the following reasons.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). Applicants submit that there is no suggestion or motivation to combine the references that the Examiner has cited. As the Examiner states, Dohse does not disclose coating the entire surface of the color card with the first coating composition and placing perforations on the card so that a portion of the card can be detached. The Examiner has combined Teter et al. and

Lerner et al. in combination with Dohse, and has asserted that claims 1-3 and 10-13 are obvious in light of the combined references. Applicants traverse this rejection for the following reasons.

With respect to the Examiner's combination of Dohse and Teter et al., there is no suggestion in either reference to combine the references to arrive at placing perforations within the colored area of the Dohse sample sheet. Absent any suggestion or motivation to combine, it cannot be obvious to combine the references. Dohse discloses the idea of separable sections containing a colored area within the section. The perforations mentioned in Dohse clearly refer to the ability of the user to remove the separable sections themselves. There is no mention or suggestion in Dohse to have an additional set of perforations within the colored area. In fact, Dohse states in Col. 1, line 24, that the sample sheet that is disclosed therein provides that all the sections are separable, so that the section bearing a color (such as a body color) can be separately compared with a section bearing a different color (such as a trim color). The purpose of Dohse is to compare individual sections of the sample sheet by removal of individual colored sections. The set of perforations within the colored area, as taught by Teter et al. however, are part of a larger swatch card of multiple colors. Teter et al. in no way suggests that the individual colored area of the swatch card can be removed and Teter et al. does not show separable sections of color. Teter et al. in no way contemplates comparison of different colored sections of the swatch with or against one another. As such, the references serve two completely different purposes and therefore, there is no motivation to combine the Dohse and Teter et al. references.

Moreover, the Teter et al. patent does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to dried color of a commercially available paint composition. The Teter et al. patent contemplates that the blank swatches are run through a printer or copier to provide for a color on the swatches. There is no motivation to use Teter et al. to exhibit colors similar to commercially available paint colors. In fact, the reference contemplates the ability to make swatches that include colors that represent "spot" colors and textiles. Additionally, the swatches may be used to record the color samples that pertain to printing projects or advertising campaigns. Accordingly, there is no suggestion to combine the Teter et al. reference with the Dohse reference, which shows a sample sheet for displaying the color of paint.

With respect to the Lerner et al. reference, the Examiner states that Lerner shows the use of a paint chip that includes a composition covering the entire area of the surface of the chip and

includes indicia for identifying the color of the composition. As such, the Examiner states that it would have been obvious to modify Dohse by covering the entire area of the card. On the contrary, Applicants assert that it is improper to combine the Dohse and Lerner et al. references because Dohse teaches away from their combination. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). In particular, Dohse teaches away from covering the entire area of the card, and therefore modification of Dohse in light of Lerner et al. is not obvious. Dohse, column 2, line 10, states that the reference key is placed on the face of the section “adjacent” to the color that is displayed. Applicants submit that the fact Dohse expressly states that the reference key is placed adjacent to the colored area suggests that the reference keys are not intended to be placed on the colored section. As such, the sample sheet sections described in Dohse are not intended to have the entire surface area covered with a coating composition. Accordingly, it is improper to suggest the combination of Lerner et al. with Dohse to arrive at a surface area that is coated in its entirety with a colored coating composition.

With respect to claim 2, Applicants traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claim 2 in light of the failure of the references to provide any suggestion or motivation to be combined.

With respect to claims 3 and 13, Applicants traverse this rejection. The Examiner has states that Dohse discloses Applicants basic inventive concept except for making the chip sections square, but that it would have been an obvious design choice to make the chip sections square. The references that the Examiner has cited do not provide any suggestion or motivation for a square chip section. In fact, all of the references clearly provide illustrations that provide for round or rectangular sections. Additionally, the references are void of any suggestion on the shape of the sections. The failure to provide motivation or suggestion to make the chip sections square, in addition to the fact that the independent claims are not obvious, support a finding that claims 3 and 13 are also not obvious in light of the cited references.

Applicants also traverse the rejection of claim 11. With respect to claim 11, Applicants submit that none of the references that have been cited by the Examiner disclose the element of a tear line that has ends that are separated by a space in which the paint color card is not

perforated. It is clear that Dohse discloses separable areas that are defined by vertical and transverse lines of perforations (Col 1., line 41). Dohse does not contemplate separating a section along three lines and folding it along the fourth. In fact, the entire purpose of the Dohse patent is to provide for sections that are *separable*. Not providing for sections that are to be separated along all four sides of the section is contrary to the teachings of the Dohse patent, specifically that all the sections are separable, so that each section *may be separately compared* with one another (Col. 1, line 24 *et seq.*). As such, Dohse teaches away from the element of a section that may be separated along a tear line and folded along a fold line. Likewise, neither Teter et al. nor Lerner et al. disclose the claim element of “wherein at least one tear line has ends separated by a space in which the paint color card is not perforated, wherein when the at least one tear line is severed, the chip section may be folded over along a fold line to form the window.” Accordingly, claim 11 is not obvious in light of the combination of the cited references.

The Examiner has rejected claims 4 and 14 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. and Lerner as applied to claims 1 and 10, and further in view of Spangler (U.S. Patent No. 6,270,123). The Examiner states that Dohse discloses Applicants’ basic inventive concept except for making the color card out of paper. Applicants traverse this rejection for the following reasons. As Applicants have stated above, there is no suggestion to combine the Dohse, Teter et al., and Lerner et al. references to arrive at Applicants independent claims 1 or 10. The references clearly do not provide any motivation or suggestion to combine, and the Examiner has not provided any support for such motivation or suggestion. Therefore, as stated above, Dohse in view of and Teter et al. and Lerner et al. does not teach or suggest all of the limitations disclosed in claims 1 and 10, and the Examiner has not established a *prima facie* case of obviousness with respect to claims 1 and 10. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. As such, Applicants submit that claims 4 and 14 are not obvious in light of the cited references.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. and Lerner et al., and further in view of Day et al (U.S. Patent No. 4,104,809). Applicants traverse this rejection. As Applicants have stated,

above, the Dohse, Teter et al., and Lerner et al. references cannot properly be combined because of the lack of suggestion or motivation to combine. As such, independent claims 1 and 10, and their dependent claims 5-7 and 15, respectively, cannot be obvious.

The Examiner has rejected claims 8, 9, 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. and Lerner et al. as applied to claim 1 and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl. Applicants traverse this rejection for the following reasons. As Applicants have stated above, Dohse, Teter et al., and Lerner et al. are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claim 1 is not obvious and claim 9, depending from claim 1, is also not obvious. The Examiner has failed to indicate his basis for rejection of claims 25 and 26, which depend from claim 10. Applicants submit, however, that claim 10 is not obvious for reasons set forth above, and as such, claims 25 and 26 are also not obvious.

The Examiner has also rejected claims 1-3 and 10-13 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. Applicants traverse this rejection and again submit that there is no suggestion in either the Dohse or Teter et al. references to combine the references to arrive at placing perforations within the colored area of the Dohse sample sheet. Dohse discloses the idea of separable sections containing a colored area within the section. The perforations mentioned in Dohse clearly refer to the ability of the user to remove the separable sections themselves. There is no mention or suggestion in Dohse to have an additional set of perforations within the colored area. Dohse states in Col. 1, line 24, that the sample sheet that is disclosed therein provides that all the sections are separable, so that the section bearing a color (such as a body color) can be separately compared with a section bearing a different color (such as a trim color). The purpose of Dohse is to compare individual sections of the sample sheet by removal of individual colored sections. Teter et al., on the other hand, describes a set of perforations within the colored area of a swatch card containing multiple colors. Teter et al. does not describe separable sections of color. Teter et al. in no way contemplates comparison of different colored sections of the swatch with or against one another. As such, the references serve two completely different purposes. The different purposes served by the Dohse and Teter

et al. references are just one indication that there is no suggestion to combine these references. Moreover, the references themselves provide for no motivation or suggestion to combine.

There are also other reasons that show a lack of suggestion or motivation to combine. The Teter et al. patent does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to dried color of a commercially available paint composition. The Teter et al. patent contemplates that the blank swatches are run through a printer or copier to provide for a color on the swatches. There is no motivation to use Teter et al. to exhibit colors similar to commercially available paint colors. In fact, the reference contemplates the ability to make swatches that include colors that represent “spot” colors and textiles. Additionally, the swatches may be used to record the color samples that pertain to printing projects or advertising campaigns. Accordingly, there is no suggestion to combine the Teter et al. reference, which discloses a blank template for printers and copiers, with the Dohse reference, which shows a sample sheet for displaying the color of paint.

With respect to the rejection of claim 3, the Examiner has states that Dohse discloses Applicants basic inventive concept except for making the chip sections square, but that it would have been an obvious design choice to make the chip sections square. Neither the Dohse nor Teter et al. references provide any suggestion or motivation for a square chip section. In fact, the Teter et al. reference clearly includes illustrations that provide only for round sections, and the separable sections as taught in Dohse are rectangular. The references are void of any suggestion on the shape of the sections. The failure to provide motivation or suggestion to make the chip sections square, in addition to the fact that the independent claims are not obvious, support a finding that claims 3 and 13 are also not obvious in light of Dohse in view of Teter et al.

Additionally, with respect to the rejection of claim 11, Applicants submit that neither Dohse nor Teter et al. disclose the element of, what the Examiner refers to as, a perforated section that can be separated along three sides and folded along the fourth. It is clear that Dohse discloses separable areas that are defined by vertical and transverse lines of perforations (Col 1., line 41). Dohse does not contemplate separating a section along three lines and folding it along the fourth. In fact, the entire purpose of the Dohse patent is to provide for sections that are *separable*. Not providing for sections that are to be separated along all four sides of the section in contrary to the teachings of the Dohse patent, specifically that all the sections are separable, so that each section *may be separately compared* with one another (Col. 1, line 24 *et seq.*). As

such, Dohse teaches away from the element of a section that may be separated along a tear line and folded along a fold line. Teter et al. also does not disclose or suggest the claim element of “wherein at least one tear line has ends separated by a space in which the paint color card is not perforated, wherein when the at least one tear line is severed, the chip section may be folded over along a fold line to form the window.” Throughout the disclosure, the perforated sections are always depicted as circular holes. Moreover, there is no section of the perforated area that has a space of non-perforation. Therefore, it would be impossible to be able to fold over the perforated section to create an opening as it is claimed in Applicants claim 11.

For the foregoing reasons, Applicants do not believe that the combination of the Dohse and Teter et al. references are a proper basis for an obviousness rejection on claim 1-3 and 10-13.

The Examiner has rejected claims 4 and 14 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. Applicants submit that there is no suggestion to combine the Dohse and Teter et al. references. Dohse and Teter et al. clearly do not provide any motivation or suggestion to combine the two references, as shown above with respect to independent claims 1 and 10, and the Examiner has not provided any support for such motivation or suggestion. Therefore, the Examiner has not established a *prima facie* case of obviousness with respect to claims 1 and 10. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. As such, Applicants submit that claims 4 and 14 are not obvious in light of the cited references.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. and further in view of Day et al (U.S. Patent No. 4,104,809). Applicants traverse this rejection. The Dohse and Teter et al. references cannot properly be combined because of the lack of suggestion or motivation to combine them. Applicants have provided arguments in favor of this position with respect to independent claims 1 and 10, above. As such, dependent claims 5-7 and 15 also cannot be obvious.

The Examiner has rejected claims 8, 9, 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. as applied to claim 1 and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl. Applicants traverse this rejection for the

following reasons. As Applicants have stated above, Dohse and Teter et al. are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claim 1 is not obvious and claim 9, depending from claim 1, is also not obvious. The Examiner has failed to indicate his basis for rejection of claims 25 and 26, which depend from claim 10. Applicants submit, however, that claim 10 is not obvious for the reasons set forth above, and as such, claims 25 and 26 are also not obvious.

The Examiner has rejected claims 1-4 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Lerner et al. in view of Teter et al. Applicants traverse this rejection for the following reasons. The Examiner states that Lerner et al. shows a paint color card comprising a layer of a first colored coating composition formulated to have a dried color that is substantially similar to dried color of a commercially-available paint composition. The Examiner further states that Lerner et al. does not disclose placing perforations on the card so that a portion of the card can be detached, but that in view of the teachings in Teter et al., it would have been obvious to modify Lerner et al. by adding an additional set of perforations to each of the colored coating compositions. Applicants submit that neither Lerner et al. nor Teter et al. provide the requisite suggestion or motivation to combine the two references. The inventions described in the two references serve completely different purposes, purposes that are not compatible. The Lerner et al. reference discloses a perforated section in the context that the chip section can be removed from the mount base by tearing along the perforation. The removed chip can then be applied to a variety of surfaces because the backside of the chip contains an adhesive. The Lerner et al. reference specifically teaches away from being combined with a color card that has multiple non-removable colors. Specifically, in Col.1, line13, the Lerner et al. reference indicates that color display cards that contain a plurality of colors are problematic in that they are a distraction to the user who would desire to view a color apart from surrounding colors. The type of color display that Lerner et al. is claiming is undesirable is indeed the type of display that is taught in Teter et al., i.e., a plurality of non-removable colors on a swatch card. As such, the two references are not suggested to be combined and Lerner et al. in fact teaches away from its combination with Teter et al. Moreover, Teter et al. provides no disclosure or suggestion that the blank color card may exhibit colors that are formulated to have a dried color that is substantially similar to dried color of a commercially available paint composition. The Teter et al. patent contemplates that

the blank swatches are run through a printer or copier to provide for a color on the swatches. There is no motivation to use Teter et al. to exhibit colors similar to commercially available paint colors. In fact, the reference contemplates the ability to make swatches that include colors that represent “spot” colors and textiles. Additionally, the swatches may be used to record the color samples that pertain to printing projects or advertising campaigns, but Teter et al. never contemplates or suggests the use of colors that are intended match dried colors of a paint composition.

There is also no suggestion in Lerner et al. to have an additional set of perforations within the colored area of the paint chip. The set of perforations within the colored area, as taught by Teter et al. are part of a larger swatch card of multiple colors. Teter et al. in no way suggests that the individual colored area of the swatch card can be removed.

Furthermore, the purposes and uses of the inventions provided for in the Teter et al. and Lerner et al. references are different and contrary to one another, i.e., Teter et al. provides for a color swatch template depicting multiple colors, Lerner et al. provides for a color display to remove color chips to avoid viewing multiple colors at once. Thus, the Lerner et al. reference teaches away from the Teter et al. reference, and vice versa.

Lerner et al. also requires that the removable paint chips include an adhesive on the backside of the chips so that the chips may be placed on any number of surfaces. It would be difficult for a user to peel off the paint chip from the display sheet and then attempt to “pop out” or move a perforated section within the paint chip as he/she is holding an adhesive-backed chip. The chips disclosed by Lerner et al. must be allowed to be repositioned without losing the integrity and strength of the adhesive. The Lerner et al. reference specifically states that the chips are intended to be repositioned. Therefore, it follows that the adhesive must remain “tacky” enough to be applied and reapplied onto various surfaces. Applicants submit that it would be difficult to peel off the paint chip as disclosed in Lerner et al. and attempt to remove a perforated section without the users fingers coming into constant contact with the adhesive backing. Such contact would diminish the effectiveness of the adhesive and the chip may therefore not be positionable on many surfaces. Accordingly, placing perforated sections within the colored area of Lerner et al. would interfere or even contradict the intended purpose and use of the invention disclosed in Lerner et al.

For the foregoing reasons, there is no motivation or suggestion to combine the teachings of Lerner et al. in view of Teter et al., and furthermore, the teachings of each reference teach away from the purpose of the other.

Additionally, the invention disclosed in Teter et al. is a swatch template that is intended to be used by any person through a printer or copier. There is no motivation, as disclosed in the Lerner et al. and Teter et al. references, for applying the concepts of a swatch card template to a color swatch display with removable paint chips.

For all of the foregoing reasons, Applicants do not believe that it would be obvious to combine the teachings of Lerner et al. and Teter et al. with respect to independent claims 1 and 10, and all of the claims depending therefrom.

With respect to the Examiner's rejection of claim 3 and 13 based on Lerner et al. in view of Teter et al., Applicants submit that neither the Lerner et al. or Teter et al. reference provide any suggestion or motivation for a square chip section. In fact, the references clearly provide illustrations that teach round or rectangular sections. Additionally, the references are void of any suggestion on the shape of the sections. The failure to provide motivation or suggestion to make the chip sections square, in addition to the fact that independent claims 1 and 10 are not obvious, support a finding that claims 3 and 13 are also not obvious in light of the cited references.

Additionally, with respect to the rejection of claim 11, Applicants submit that neither Lerner et al. nor Teter et al. disclose the element of, what the Examiner refers to as, a perforated section that can be separated along three sides and folded along the fourth. Lerner et al. provides for one perforated section in the context that the chip section can be removed from the mount base by tearing along the perforation. In fact, the purpose of the perforated section as described in Lerner et al. is to provide a removable paint chip. Lerner et al. clearly contemplates that each chip is intended to be removed and separated from the other chips on the display. As previously mentioned, that is one way in which Lerner et al. differentiates itself from other paint color cards that includes multiple colors displayed thereon (Col. 1, line 13). As such, Lerner et al. teaches away from the element of a section that may be separated along a tear line and folded along a fold line. Teter et al. also does not disclose or suggest the claim element of "wherein at least one tear line has ends separated by a space in which the paint color card is not perforated, wherein when the at least one tear line is severed, the chip section may be folded over along a fold line to form the window." Throughout the disclosure, the perforated sections are always depicted as

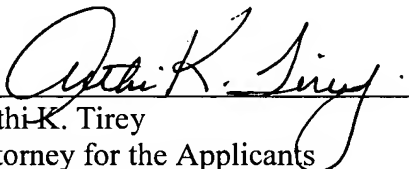
circular holes. Moreover, there is no section of the perforated area that has a space of non-perforation. Therefore, it would be impossible to be able to fold over the perforated section to create an opening based on the teachings of the reference to arrive at Applicants claim 11. For the foregoing reasons, Applicants do not believe that the combination of the Lerner et al. and Teter et al. references are a proper basis for an obviousness rejection of claim 11.

With respect to the Examiner's rejection of claims 5, 6, and 15 under 35 U.S.C. 103(a), Applicants submit that Lerner et al. in view of Teter et al. is not properly combinable because there is no suggestion or motivation to combine the two references. Applicants, based on the foregoing arguments, believe that independent claims 1 and 10 are not obvious and therefore claims 5 and 6, depending from claim 1, and claim 15, depending from claim 10 also cannot be obvious.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If the Examiner has any questions with respect to the foregoing, he is invited to contact the undersigned. Applicants would like to again thank the Examiner for his review of the subject application.

Respectfully submitted,

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